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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/961,234	09/24/2001	William A. Royall JR.	ROY03 001	6263

7590
Duane Morris LLP
1667 K Street, N.W.
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Washington, DC 20006

02/07/2006

EXAMINER

CORRIELUS, JEAN M

ART UNIT	PAPER NUMBER
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2162

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/961,234	Applicant(s) ROYALL ET AL.	
	Examiner Jean M. Corrielus	Art Unit 2162	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 January 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

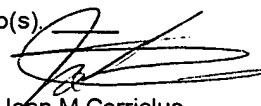
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: _____.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s).
 13. ☐ Other: _____.


 Jean M Corrielus
 Primary Examiner
 Art Unit: 2162

Continuation of 11. does NOT place the application in condition for allowance because: Applicants asserted that it is well settled that to rely on inherency, the feature must be necessarily present, not possibly present or even likely present, but necessarily present, the office's implications clearly fail the inherency test, therefore, Tjaden does not disclose, teach or suggest "providing a unique access number to a candidate, rather Tjaden discloses assigning an identification code for an institution participating in Tjaden's proposed survey. Tjaden does not disclose "electronically mailing each candidate in the target group the assigned PIN and an invitation to use the PIN to access the web site; providing each candidate accessing the web site an indicating a continuing interest in the education institution with electronic access to a partial application and customizing, compiling or transmitting the partial application to the institution. In rejecting claims under 35 U.S.C 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. (see *In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in *Graham V. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *Uniroval, Inc. v. Rudkin-Wiley Coro.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434; *Ashland Oil Inc. v. Delta Resins & . Refractories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); *ACS Hosp. Svs., Inc. v. Montefiore Hosp* F.2d 1572, 1577, 221 USPQ 929, 933 (Fed.1984). These showings by the examiner are an essential part of complying with the obviousness. Note *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See *id.*; *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, (CCPA 1976).

he examiner's position is that Grady does not disclose the steps provide each target group with a unique access number, electronically mailing each candidate in the target group the assigned PIN, providing each candidate with accessing the web site and compiling, transmitting or transmitting the partial application to the institution. To overcome these deficiencies of Tjaden, the examiner turns to Tjaden for assigning PIN to each candidate, electronically mailing each candidate in the target group the assigned PIN, providing access to the web site compiling and transmitting partial application to institution. Applicant's position is that the examiner fails to show prima facie evidence of the applicant claimed invention. From reviewing Grady and Tjaden, it is agreed with the examiner for the reasons set forth in the final rejection, as amplified by the analysis below, that the applied prior art would have suggested to an artisan the invention of claim 1. The applicant does not dispute the examiner's mapping correspondence of the claimed language, but rather assert that the Tjaden's reference fails to disclose the invention as claimed without providing how the cited portion of the examiner interpretation is differed from the claimed invention. It is unclear as to whether the combination of Grady and Tjaden would render the system of Grady useless or unworkable for it intended function. From all of the above, The examiner is not convinced of any error and the rejection of claims 1-4 and 7-8 under 35 U.S.C 103(a) is proper. .